REMARKS – Summary

The Examiner's rejections are respectfully flawed for two principal reasons:

1. First and contrary to the assertion made in the rejection, there are a number of limitations found in the independent claims 14, 36, and 45, specifically Claim 14 Clauses (c)(ii), (c)(iv), (c)(v), (c)(vi); Claim 36 Clauses (c)(ii), (c)(iv), (c)(v), (c)(vi), and Claim 45 Clauses (b), (c), (d) and (e), that are not taught or suggested in Petrovich. Moreover, these limitations are also missing from Suzuki and Ruppert.

   Therefore, a *prima facie* case of obviousness *cannot* be established by these three references with respect to above-identified limitations.

2. Second, the limitation regarding the prediction of the product to be replaced, i.e., Claim 14 Clauses (c)(iv), (c)(v), (c)(vi); Claim 36 Clauses (c)(iv), (c)(v), (c)(vi), and Claim 45 Clauses (c), (d) and (e), is, in fact, *not* taught *or* suggested by Suzuki.

   Therefore, even if Suzuki is combined with Petrovich, the invention as defined by the independent claims would *not* be present through a modification of Petrovich and a *prima facie* case of obviousness is *not* established.

Any continued allegation that Petrovich and / or Suzuki can be modified so that the missing claim limitations are present is a clear use of hindsight, which the USPTO Board of Appeals has ruled against, in agreement with the courts.

That the suggestion to combine the references should ***not*** come from the Applicant was forcefully stated in Orthopedic Equipment Co, v. United States, 217 U.S.P.Q. 193, 199 (C.A.F.C. 1983):

> "It is wrong to use the patent in suit as a guide through the maze of prior art references, combining the right references in the right way to achieve the result of the claims in suit. Monday morning quarterbacking is quite improper when resolving the question of nonobviousness in a court of law".

As was further stated in Uniroyal, Inc. v. Rudkin-Wiley Corp., 5 U.S.P.Q. 2d 1434 (C.A.F.C. 1988):

> "[w]here prior-art references require selective combination by the court to render obvious a subsequent invention, there must be some reason for the combination other than hindsight gleaned from the invention itself.... *Something in the prior art must suggest the desirability and thus the obviousness of making the combination.*" [Emphasis applied]

In line with these decisions, the Board stated in Ex parte Levengood, 28 U.S.P.Q. 2d 1300 (P.T.O.B.A.&I. 1993):

> "In order to establish a *prima facie* case of obviousness, it is necessary for the examiner to present *evidence*, preferably in the form of some teaching, suggestion, incentive, or inference in the applied prior art, or in the form of generally available knowledge, that one having ordinary skill in the art *would have been led* to combine the relevant teachings of the applied references in the proposed manner to arrive at the claimed invention. ... That

> which is within the capabilities of one skilled in the art is not synonymous with obviousness. … That one can *reconstruct* and / or explain the theoretical mechanism of an invention by means of logic and sound scientific reasoning does not afford the basis of obviousness unless that logic and reasoning also supplies sufficient impetus to have led to one of ordinary skill in the art to combine the teachings of the references to make the claimed invention…. Our reviewing courts have often advised the Patent and Trademark Office that it can satisfy the burden of establishing *a prima facie* case of obviousness by some objective teaching in either the prior art, or knowledge generally available to one of ordinary skill in the art, that "would lead" that individual to "combine the relevant teachings of the references."… Accordingly an examiner cannot establish obviousness by locating references which describe various aspects of a patent applicant's invention without also providing evidence of the motivating force which would impel one skilled in the art to do what the patent applicant has done.".

Applicant respectfully submits that combining Petrovich, Suzuki and Ruppert is *not* legally justified and is therefore improper [In re Sernaker, 217 U.S.P.Q. 1, 6 (C.A.F.C. 1983), Orthopedic Equipment Co, v. United States, 217 U.S.P.Q. 193, 199 (C.A.F.C. 1983), Uniroyal, Inc. v. Rudkin-Wiley Corp., 5 U.S.P.Q. 2d 1434 (C.A.F.C. 1988) and Ex parte Levengood, 28 U.S.P.Q. 2d 1300 (P.T.O.B.A.&I. 1993)]. Thus Applicant respectfully submits that the rejection on these references be withdrawn.

REMARKS – General

1. Re Examiner's response [4], Applicant amended pertinent claims to overcome this rejection.

2. Re Examiner's response [5], Applicant amended pertinent claims to overcome this rejection.

3. Re Examiner's response [5], Applicant traversed Examiner's previous MPEP §608.01(v) objection of the use of the term "**Bluetooth**", but Examiner did not address Applicant's traversal in this continued rejection.

Applicant clearly demonstrated in response to the previous Office Action (i.e. Applicant's Amendment E dated April 02, 2008) that the term "**Bluetooth**" is used in many currently issued USPTO patent applications. To date (i.e. Feb. 04, 2009) there are *one thousand, four hundred and eighty five (1,485)* issued USPTO patents that use Examiner's objected to term "**Bluetooth**" in their claims.

Applicant respectfully requests that the Examiner reconsiders the MPEP §608.01(v) objection to Applicant's use of the term '**Bluetooth**' in Claims 16 and 38 based on this overwhelming USPTO precedence in the use of the term '**Bluetooth**' in issued patents claims.

(3.1) Applicant's previous, pertinent traversal of Examiner's rejection is as follows (i.e. Applicant's Amendment E dated April 02, 2008):

"Applicant's respectful request is based on the following US Patent Office precedence:

As of Applicant's online search dated March 24, 2008

of the US PTO's Issued Patents database (PatFT) using the search term **'Bluetooth'** in issued patents (i.e. ACLM/bluetooth), the PatFT system returned one thousand, one hundred and seventy-five (1,175) patents. The earliest US issued patent to use the term **'Bluetooth'** in its claims is Madsen, et al. patent number 6,181,284, issued January 30, 2001. The most recent issued patent to use the term **'Bluetooth'** in its claims is Hullot, et al. patent number 7,346,705, issued March 18, 2008.

It is commonly known in the art that a **'Bluetooth'** network that communicates between two pertinent devices provides more than a "**Short range radio frequency link**". A **'Bluetooth'** communications network includes providing:
(a) a physical radio channel which is shared by a group of devices that are synchronized to a common clock and frequency-hopping pattern, (b) a piconet consisting of Master and Slave Devices, in which one device provides the synchronization reference and is known as the master. All other devices are known as slaves. A group of devices synchronized in this fashion form a piconet. This is the fundamental form of communication for Bluetooth wireless technology. Devices in a piconet use a specific frequency-hopping pattern that is algorithmically determined by certain fields in the Bluetooth specification address and clock of the master. The basic hopping pattern is a pseudo-random ordering of the 79 frequencies in the ISM band. The hopping pattern may be adapted to exclude a portion of the frequencies that are used by

interfering devices. The adaptive hopping technique improves Bluetooth technology co-existence with static (non-hopping) ISM systems when these are co-located. Piconets are established dynamically and automatically as Bluetooth enabled devices enter and leave radio proximity. A fundamental Bluetooth wireless technology strength is the ability to simultaneously handle both data and voice transmissions. [source: Bluetooth Special Interest Group (SIG)].

In consideration of the above US Patent Office precedence in using the term **'Bluetooth'** in over 1,100 US Issued Patents' claims, and the commonly known art that a **'Bluetooth'** network is much more than a "**Short range radio frequency link**", Applicant respectfully requests that the Examiner allows the term **'Bluetooth'** in Claims 16 and 38 to overcome the Rejection under MPEP § 608.01(v)."

(3.2) Applicant respectfully requests that if Examiner continues to reject the use of the term "**Bluetooth**" in Applicant's invention's claims, to please state why *1,485* currently issued USPTO patents should continue to be able to claim this term, whereas Applicant's application cannot use the term "**Bluetooth**" in a similar manner.

Re Examiner's Response To Applicant's Claims

4. Re Examiner's response [8], Applicant respectfully requests that Examiner reconsiders Rejections under 35 USC § 103 of Claims 14-20 and 34-46 as being un-patentable over Petrovich et al (US PG Pub. No. 2003/0061113 A1) in view of the Suzuki (US Patent No. 6,129,274), as well as in view of

Ruppert et al (US Patent No. 5,424,524). Applicant has amended pertinent claims to overcome this rejection. Furthermore Applicant has added new Claims 63 and 64.

Petrovich et al, Suzuki and Ruppert et al do *not* teach the *new and unexpected use* of date and time stamps of previously entered product barcodes *to set up a predictive shopping list database of a consumer's commonly and frequently used / needed products, using the consumer's own computer*. This shopping list database in the Applicant's invention is used not only to generate a list of barcoded products that the consumer has currently entered into the system (e.g. on March 24, 2008 at 10:00), but is used as well in order *to predict* if and when the consumer will need to shop (in-store or online) for a product which the consumer may not be aware of at the current moment (e.g. on March 24, 2008 at 10:00), i.e. when the consumer generates a new / current shopping list.

Applicant's claimed invention [specifically Claims 14(iv), 14(v), 14(vi), 36(iv), 36(v), 36(vi) and 45(b), 45(c), 45(d) and 45(e)] will ascertain whether or not previously entered barcoded products (e.g. on March 1, 2008 at 08:00, on March 14, 2008 at 17:00 and on March 17, 2008 at 20:00), should also be placed on the consumer's current shopping list (e.g. on March 24, 2008 at 10:00) *even though the consumer has not entered the products' barcodes on his current / new shopping list.*

In other words, Applicant's invention learns *over a period of time*, i.e. over multiple dates and times (and not via single date as Suzuki teaches, i.e. using the "**`last purchase date`**"), the consumption habits of the consumer by building a database of previously entered shopping lists, by including the date and time, every time the consumer enters each product into the invention.

This *new and unexpected use* of the date and time on which a product's barcode was previously entered into a shopping list in Applicant's invention is

important to the Applicant's invention's *non-obvious* use of a predictive shopping list database to aid a consumer. *Consequently Applicant's invention can automatically add items to the consumer's current / new shopping list, even though the consumer may be unaware that he needs the item(s), which the invention automatically adds to his current / new shopping list.*

4.1) Examiner's rejections of Claim 14 (a) through (c) have been overcome by amending Claim 14.

4.2) Examiner's rejection of Claim 14 (d) by citing Petrovich "**(see at least Para 0118, 0103-109)**" does *not* address Applicant's claim of "`transferring said scanned product barcode or said product coupon barcode to said consumer's first computer, over said first network infrastructure`".

Petrovich's "**host computer**" is clearly *not* Applicant's claimed "`consumer's first computer`", but a computer which belongs to a "**shopping establishment**" (see at least **Fig 1, symbol 16; Abstract; Para 0015-0020; Para 0061-0063; Para 0068-0070; Para 0086-0090; Para 0097-0099; Para 0104-0105; Para 0108; Para 0118; Para 0122; Para 0124; Para 0128-0129; Para 0137-0138; Para 0141**).

This is an important distinction in the use computer systems between Petrovich and Applicant's invention. Petrovich relies on the "**shopping establishment**" to provide information and processing, whereas Applicant's "`consumer's first computer`" provides the processing and intelligence needed in setting up and maintaining a consumer's predictive shopping list database, which Petrovich does *not* teach.

4.3) Examiner's rejection of Claim 14 (e) by citing Petrovich "**(see at least Para 0012, 0020, 0068)**" clearly do *not* teach Applicant's claim of "storing said transferred product barcode or said product coupon barcode in a shopping list database **on said consumer's first computer**".

Petrovich **Para 0012** states: "It is yet a further object of the present invention to provide *an* ***improved portable terminal*** which can be used by a given consumer *in both a home and store location*, and can perform enhanced shopping database management." Clearly there is *no* mention of Applicant's claim 13 (e), i.e. "storing said transferred product barcode ... in a shopping list database on said consumer's first computer".

Petrovich **Para 0020** clearly discusses "storing data associated with the bar codes **in a memory of the portable terminal**" and *not* "storing said transferred product barcode ... in a shopping list database on said consumer's first computer" as claimed by Applicant.

Petrovich's "**portable terminal**" cannot be construed under any circumstance as Applicant's claimed "consumer's first computer".

Petrovich **Para 0068** clearly discusses a "home data transfer circuit 36 supplies **host computer 16** with the data associated with the bar codes of the shopping-related items 44 when the **portable**

terminal 40 is received in the home portable terminal-receiving station 32 ... **Host computer 16** receives the data associated with the bar codes of the shopping-related items 44 and stores the data in a shopping list database".

Petrovich's "**host computer**" clearly belongs to the "**shopping establishment**" and is *not* a "consumer's first computer" as claimed by Applicant.

It is clear that Petrovich does *not* teach "storing said transferred product barcode or said product coupon barcode in a shopping list database **on said consumer's first computer**" as claimed by Applicant. Clearly Petrovich teaches storing bar codes on a "**portable terminal**", i.e. a barcode scanner, and then transferring this list from the scanner to a "**shopping establishment's host computer**", and thereby does *not* teach Applicant's invention.

4.4) Examiner's rejection of Claim 14 (f) by citing Petrovich "**(see at least Para 0005 ... 0012,0016,0017,00103-109)**" clearly does *not* teach Applicant's claim.

Petrovich **Para 0005** teaches US Patent No. 5,047,614 to Bianco, wherein a person "can **dock the bar code reader in a kiosk at a store,** and can then receive a printed shopping list with directions".

Clearly Bianco in Petrovich **Para 0005** does *not* teach "obtaining in-hand said stored current shopping list information from said ***consumer's first computer***

in order to go to a first store" as claimed by Applicant, but teaches the need to go ***first*** to "a store" in order to "receive printed shopping list".

Petrovich **Para 0012,0016,0017,0103-0109** clearly do *not* teach the capability of "obtaining in-hand said stored current shopping list information from said **consumer's first computer in order to go to a first store**" as claimed by Applicant.

Petrovich **Para 0012** does *not* teach using a consumer's first computer but teaches "an improved portable terminal", which is analogous to Applicant's portable barcode scanner.

Petrovich **Para 0016** teaches a "shopping establishment kiosk cradle" and *not* a "consumer's first computer", i.e. ***in-store*** use of Petrovich.

Petrovich **Para 0017** teaches a "home cradle" and a "home data transfer circuit supplies the host computer with the data associated with the bar codes when the portable terminal". As discussed above (see [4.2]), clearly Petrovich's "**host computer**" belongs to the "**shopping establishment**", i.e. a store, and is *not* a "consumer's first computer" as claimed by Applicant.

Petrovich **Para 0103-0109** teaches ***in-store use*** of Petrovich's "portable terminal" and *not* "obtaining in-hand said stored current shopping list information **from said consumer's first computer in order to go to**

a first store" as claimed by Applicant.

Clearly Examiner's cited references do *not* teach Applicant's invention.

4.5) Applicant's Claim 14 (g) and 14(h) have been rewritten as part of amended Claim 16.

4.6) Examiner's rejection of Claim 14 by citing Suzuki (**see at least col. 14 lines 1-35**) "teaches wherein the processor based on customer's shopping istory [*sic*] information (i.e. previous shopping list) is able to make purchase recommendations for replenishment items by analyzing the **last purchase date of a necessity item from the shopping history**".

Examiner then claims that it "would have been obvious to one of ordinary skil [*sic*] in the art at te [*sic*] time the invention was made to incorporate the teachings of Suzuki to the disclosure of Petrovich in order to refill or replenish frequently needed items".

Applicant respectfully disagrees with Examiner's conclusions for the following reasons:

i. Firstly, Suzuki relies simply on the "**last purchase date** of a necessity item from the shopping history" as specified by Examiner's reference (see **col. 14 lines 1-35**), whereas Applicant's invention claims using a *multiplicity* of an item's previously scanned / entered dates and times in order to determine the consumer's rate of consumption of any product,

whether or not it may be regarded as a "**necessity**", (i.e. setting up and maintaining a *predictive* shopping list database on a consumer's computer, which Suzuki clearly does *not* disclose).

For example, consider a consumer who only purchases dish-wash liquid once a month (e.g. a large container), but shops, at a minimum, weekly for groceries, etc. In this scenario, Suzuki would *not* determine, after four separate visits of shopping by the consumer, that dish-wash liquid is needed, whereas Applicant's invention would determine such a need. Clearly in this case, Suzuki does *not* teach Applicant's claimed invention.

ii. Suzuki teaches using the "**last purchase date** of a necessity item from the shopping history" at a store's checkout (see **col. 14 lines 1-35**), which is stored in an "IC card" carried by the consumer (see at least **Fig. 1, Fig. 2; col. 1 lines 7-12; col. 4 lines 13-19; col. 6 lines 15-67; col. 9 lines 1-67; col. 11 lines 3-19, 60-67; col. 12 lines 35-42** and **col. 14 lines 1-35**).

Suzuki's solution is therefore limited to stores that have implemented Suzuki's invention. So for example, consider if a consumer decides to shop at another store, which could be a competitor's store, and where Suzuki's invention has *not* been implemented. In this case the consumer would *not* be the recipient of the store being "able to make purchase recommendations for replenishment items by analyzing the last purchase date of a necessity item from the shopping history".

This further limitation of Suzuki does *not* teach Applicant's

invention which does *not* rely any specific store implementing Applicant's invention, i.e. unlike Suzuki which requires a consumer to use Suzuki's invention's "IC card" and to shop at a store which has implemented Suzuki's invention, specifically the associated "IC card" reader software, as well as software on the store's computer, that is "able to make purchase recommendations for replenishment items by analyzing the last purchase date of a necessity item from the shopping history".

iii. Suzuki teaches that for a consumer to be reminded for a "necessity item from the shopping history", the consumer must be ***in a store*** using a specific portable "IC card" (see at least **Fig. 1, Fig. 2; col. 1 lines 7-12; col. 4 lines 13-19; col. 6 lines 15-67; col. 9 lines 1-67; col. 11 lines 3-19, 60-67; col. 12 lines 35-42** and **col. 14 lines 1-35**).

This further limitation of Suzuki *teaches away* from the Applicant's invention that does *not* rely on a specific store's capability to read, **in-store**, a consumer's "shopping history" off of a consumer's Suzuki "IC card" in order to be reminded of any items which the consumer may have, or soon will be running out of.

In conclusion it would *not* have been obvious to one of ordinary skill in the art at the time of the Applicant's invention, that to incorporate Suzuki to the disclosure of Petrovich would "remind the customer to refill or replenish frequently needed items" in a manner which Applicant's invention claims. In other words, combining Suzuki in view of Petrovich clearly does *not* teach Applicant's claimed invention.

4.7) Examiner, on Page 7 states that it "would have been obvious to one of ordinary skill in the art at the time of the invention was made to modify the disclosure of Petrovich in view of Suzuki to include the time and date of when the barcode was scanned in order to create an efficient shopping list for the customer". As clearly shown above in [4.6] by Applicant, Petrovich in view of Suzuki does *not* teach Applicant's invention.

4.8) Examiner, on Page 7, states that "the recording [of] the date and time of when [a] barcode was scanned is well known and old in the art at the time the invention was made as stated in the previous action, and is admitted [as] prior art since applicant failed to properly traverse the Official notice in the previous action".

Applicant respectfully objects to Examiner's Official Notice conclusion in this case and admittance of this information as prior art.

Applicant's objections are as follows:

i. The Applicant did traverse this objection by Examiner in the previous action (i.e. Applicant's Amendment E dated April 02, 2008) and clearly showed that Applicant's use of the date and timestamp of a scanned barcode is *non-obvious* in consideration of prior art.

Furthermore, in this current Office Action (dated Oct. 30, 2008),

Examiner did *not* point out why the Applicant's traversal was unacceptable (i.e. Applicant's Amendment E dated April 02, 2008), as required by 37 CFR 1.104(c)(2) and as stated in *Zurko, 258 F.3d at 1386, 59 USPQ2d at 1697.*

Examiner simply stated in the current Office Action (dated Oct. 30, 2008), on Page 9 in the **Response to Arguments**:
"Applicant's arguments have been considered but are moot in view of new ground(s) of rejection".

ii. Furthermore, Examiner's claim of Official Notice was and continues to be *unsupported by documentary evidence*. In the previous office action (i.e. Applicant's Amendment E dated April 02, 2008) Applicant respectfully *challenged* Examiner's Official Notice and respectfully requested evidence to support this claim [37 C.F.R. 1.104(c)(2), 37 C.F.R. 1.104(d)(2) and *Zurko, 258 F.3d at 1386, 59 USPQ2d at 1697*]. Examiner did *not* provide this evidence in the current Office Action (dated Oct. 30, 2008) in response to Applicant's challenge.

Once again, Applicant respectfully *challenges* Examiner's "**Official Notice that the time and date of when the barcode was scanned is well known and old in the art at the time of invention**" and again respectfully requests evidence to support this claim in accordance with 37 C.F.R. 1.104(c)(2), 37 C.F.R. 1.104(d)(2) and *Zurko, 258 F.3d at 1386, 59 USPQ2d at 1697.*

4.9) Applicant's previous traversal of this objection is included below, which remains pertinent to the current Official Notice (dated Oct. 30, 2008) objection by the Examiner:

"7.3) The Examiner's taking Official Notice that "**including the time and date when the barcode was scanned is well know and old in the art at the time the invention was made**" is noted, but Applicant respectfully brings the Examiner's attention to the fact that *how*, i.e. the manner in which the date and time stamp is *used* by Applicant's invention is *new and unexpected* and therefore non-obvious in the art. Applicant has modified Claims 14 and 36 to further clarify this non-obvious *new and unexpected use* of an entered barcode's date and time stamp.

Applicant teaches the non-obvious *new and unexpected use* of the entered barcode's date and time stamp to create on the "consumer's first computer" a predictive shopping list database of the consumer's past consumption habits. This predictive shopping list database system is activated when the consumer creates a new shopping list (i.e. a current shopping list) in order to go shopping. This activation includes automatically placing, i.e. adding items to the current shopping list, without the consumer's "current" intervention, because it "knows" products that the consumer has most probably run out of, or is soon to run out of and consequently most probably needs, but has neglected (i.e. has forgotten or is unaware of the current need) to enter the item(s) on the current shopping list.

In the advent that this clarification of Applicant's invention's non-obvious, *new and unexpected use* of the entered barcode's date and time stamp is respectfully unsatisfactory in the Examiner's continued taking Official Notice, Applicant respectfully challenges the Examiner's "**Official Notice that the time and date of when the barcode was scanned is well known and old in the art at the time of invention**" and respectfully requests evidence to support this claim (see 37 C.F.R. 1.104(c)(2), 37 C.F.R. 1.104(d)(2) and *Zurko, 258 F.3d at 1386, 59 USPQ2d at 1697*)

8) The Examiner's response [A] that Applicant "**failed to specially point out the supposed errors in the examiner's action**" with respect to the Examiner's taking Official Notice of the date and time stamp use has been addressed in part in Applicant's Remarks [7.3] above. Applicant shall endeavor to further traverse the Examiner's position in light of the requirements of 2144.03(c) as follows:

8.1) As stated in [7.3] above, Applicant's invention's teaching of the *new and unexpected use* of the entered barcodes' date and time stamps *in order to build a predictive shopping list database of the consumer's past consumption habits*, over a period of time, is non-obvious in the art.

In order further to traverse this argument, Applicant considers both of the sets of "References Cited" in, and "Referenced By" Ruppert et al. that use the terms (a) "**bar code**" or "**barcode**" and (b) "**timestamp**" or "**time stamp**" in each of the appropriate references' Specifications in order to determine whether or not Applicant's specific use of the date and time stamp of an entered barcode is "**well known and old in the art at the time of invention**".

8.1.1.) The only "References Cited" in Ruppert et al which include the above mentioned relevant terms (a) and (b) under consideration is Gutman et al patent number 5,221,838 (Gutman '838). Gutman '838 teaches "*a time stamp may be stored into memory 206 along with the received and recovered message information*" [col. 7, lines 10-11], and hence "*time information may be included with the message that is transmitted to the selective call receiver 200*" [col. 11, lines 32-34].

At no point is it taught, nor suggested in Gutman '838, nor in any of the other five (5) "References Cited" in Ruppert et al, Applicant's non-obvious *new and unexpected use* of the entered barcode's date and time stamp *to create an active*

predictive shopping list database system on the consumer's computer, which assists the consumer to shop for items that he has neglected to add to his current shopping list.

Gutman '838 teaches away from Applicant's *new and unexpected use* of an entered barcode's date and time stamp. Furthermore, the majority of the "References Cited" in Ruppert do not even mention capturing an entered barcode's date and time stamp, and hence do not teach either the non-obvious *new and unexpected use* of the date and time stamp in order to create a predictive shopping list database as is taught by Applicant's invention, nor "**that the time and date of when the barcode was scanned is well known and old in the art at the time of invention**" as claimed by the Examiner's Official Notice under consideration.

8.2) As of March 24, 2008 two hundred and sixteen (216) patents were "Referenced By" Ruppert et al. Applicant narrowed this list down to those applications that include the above-mentioned relevant terms (a) and (b) under consideration. Applicant used the PatFT Query "REF/5424524 AND SPEC/(timestamp OR "timestamp") AND SPEC/(barcode OR "bar code")". This search returned only one

(1) patent, i.e. Nulph patent number 7,247,095 (Nulph '095). Firstly, Nulph '095 was filed on October 8, 2004, i.e. after Applicant's filing date of February 13, 2001 and hence cannot be considered as prior art over Applicant's invention under 35 USC §102. Secondly, Nulph '095 teaches a "*Method and system for marketing and game selection for lottery products*" in which the date and time stamp of a gambling transaction is recorded. The "timestamp" term is mentioned twice (2) in Nulph '095, i.e. (1) "*information printed in relation to the specific lottery transaction of the player may include a date/timestamp 36 of the transaction*" [col. 10, lines 62-64] and (2) the "*date/timestamp 36 indicates that the play card 30 was printed on "Jul. 6, 2005 at 5:35 PM""*" [col. 11, lines 6-7]. Nulph '095 clearly teaches away from creating a predictive database of shopping lists as is taught by Applicant's invention. Furthermore, the majority of the "Referenced By" Ruppert do not even mention capturing an entered barcode's date and time stamp, and hence do not teach either the non-obvious *new and unexpected use* of the date and time stamp in order to create a predictive shopping list database as is taught by Applicant's invention, nor "**that the time and date of when the barcode was scanned is well known and old in the art at the time of invention**" as respectfully claimed by the Examiner's Official Notice under consideration.

8.2) In conclusion Applicant respectfully submits that the Examiner's taking Official Notice that "**including the time and date when the barcode was scanned is well known and old in the art at the time the invention was made**" is not "**well known and old in the art**", which Applicant has dutifully traversed in the above mentioned and pertinent applications. Specifically, Applicant respectfully submits that in context of Applicant's *new and unexpected use* of an entered barcode's date and time stamp *to create a predictive shopping list database system*, that *new and unexpected use* of an entered barcode's date and time stamp is neither "**well known**" nor "**old in the art**".

Using the guidance gratefully provided by the Examiner in the Office Action dated 02/11/2008 to institute a proper traversal pointing out the errors in the Examiner's Action, Applicant respectfully requests the Examiner, according to MPEP 2144.03(c), to "**provide documentary evidence in the next Office action if the rejection is to be maintained**". Alternatively Applicant respectfully requests that the invention as claimed should be considered non-obvious, making Applicant's Claims patentable under 35 USC § 103".

4.10) Examiner's rejection of Claim 15 by citing Petrovich **Para 0067** is moot because Claim 15 is a Dependent Claim.

4.11) Examiner's rejection of Claim 17 by citing Petrovich **Para 0067** is (a) moot because Claim 17 is a Dependent claim and (b) Petrovich does *not* teach Applicant's invention use of a "consumer's first computer" in a manner as claimed by Applicant's invention.

4.12) Examiner's rejection of Claim 18 by citing Petrovich **(Para 0132)** is (a) moot because Claim 18 is a Dependent Claim and (b) Petrovich **(Para 0132)** does *not* disclose all of the interfaces that Applicant's invention claims. Petrovich **(Para 0132)** simply discloses:

"If another portable terminal is inserted into a different slot while a communication session is in progress, the **serial cradle** will not allow a presently running communication session with a portable terminal to be interrupted. Instead, the serial cradle firmware remembers to establish a communication session with the newly connected portable terminal and executes synchronization thereof after completion of the currently running session."

Clearly this is *not* what Applicant's invention claimed in Dependent Claim 17.

4.13) Examiner's rejection of Claim 19 by citing Petrovich **(see at least Abstract, Para 0012-0017)** is (a) moot because Claim 19 is a Dependent Claim and (b) neither Petrovich **(see at least Abstract)**, nor Petrovich **(Para 0012-0017)** teach Applicant's *new and unexpected use* of a "consumer's first computer" (i.e. *not* a shopping establishment's host computer) *in providing a shopping list predictive database system.*

Furthermore, *nowhere* is it mentioned in Petrovich that the "consumer's first computer", or even the "shopping establishment's host computer" can be a personal computer, or a personal digital assistant, or an Internet appliance or a cell phone.

4.14) Examiner's rejection of Claim 34 by citing Ruppert **(see at least Abstract, Para 0060 or 0103)** is unclear because Ruppert is an issued patent and is not listed in paragraphs but in columns and lines. Applicant phoned the Examiner on Dec. 9, 2008 and left a voicemail message for Examiner to please clarify this apparent discrepancy. Examiner returned Applicant's inquiry on Dec. 11, 2008 and stated that this was a "typo" and should read "Petrovich **(see at least Abstract, Para 0060 or 0103)**".

In light of this clarification, Examiner's rejection of Claim 34 by citing Petrovich **(see at least Abstract, Para 0012-0017)** is (a) moot because Claim 34 is a Dependent Claim and (b) neither Petrovich **(see at least Abstract)**, nor Petrovich **(Para 0012-0017)** teach Applicant's use (i.e. to go shopping with a downloaded shopping list) of a "portable computer device". Furthermore, *nowhere* is it mentioned in Petrovich that Petrovich's "portable terminal" can be a personal digital assistant or a cell phone.

4.15) Examiner's rejection of Claim 35 by citing "Rupert" [*sic*] **(see at least Para 0060 or 0103)** is unclear because Ruppert is an issued patent and is not listed in paragraphs but in columns and lines. Applicant phoned the Examiner on Dec. 9, 2008 and left a voicemail message for Examiner to please clarify this apparent discrepancy. Examiner returned Applicant's inquiry on Dec. 11, 2008 and stated that this was a "typo" and should read "Petrovich **(see at least Para 0060 or 0103)**".

In light of this clarification, Examiner's rejection of Claim 35 by citing Petrovich **(see at least Para 0060 or 0103)** is (a) moot because Claim 35 is a Dependent Claim and (b) *not* all of the options claimed in Applicant's invention are found anywhere in Petrovich.

4.16) Examiner's rejection of Claims 20 and 42 by citing Petrovich **(see at least Para 0014-0016, 0060)** is moot because Claims 20 and 42 are Dependent Claims.

4.17) Examiner's rejection of Claims 16 and 38 by citing Petrovich **(see at least Para 0114 and 0060)** is moot because Claims 16 and 38 are Dependent Claims.

4.18) Examiner's rejection (9.) of Claims "36-37, 39-41, and 43-46, the limitations of claims 36-37, 39-41 and 43-46, are similar to the limitations of claims 14-15, 17-19, and 34-35; therefore the [claims] are rejected under the same rationale" are overcome by Applicant's pertinent rebuttal above in [4] through [4.17].

5. With respect to Applicant's responses above, namely [4] through [4.18], Applicant's cited claims are part of a larger method / system which should be viewed "as a whole" (*Graham v. John Deere, 383 U.S. 1, 148 USPQ 459 [1966]*), rather than piecemeal. When viewed "as a whole", Applicant respectfully submits that the invention is *non-obvious* and hence patentable over Petrovich in view Suzuki and in view of Ruppert under 35 USC § 103.

Conclusion

For all of the above reasons, Applicant respectfully submits that the specification and claims are now in proper form, and that the claims all define patentability over the prior art. Therefore Applicant submits that this application is now in condition for allowance, which action is respectfully solicited.

Very Respectfully,

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I certify that this correspondence will be deposited with the United States Postal Service as first class mail with proper postage affixed in an envelope addressed to: "Commissioner for Patents, P.O. Box 1450, Alexandria, VA 21313-1450, Mail Stop RCE" on the date below.

Date: 2009, February 18 Lester Suss Lester Sussman, Applicant